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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,204

03/22/2004

David A. Selby

RSW920030089US1

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06/25/2008

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EXAMINER

BOYCE, ANDRE D

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

06/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/806,204	Applicant(s) SELBY, DAVID A.	
	Examiner Andre Boyce	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 have been examined.

Claim Objections

2. Claims 7, 15 and 23 are objected to because of the following informalities: The claims include "the value of each event comprises its each events expected gain," which is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that

accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-8 are non-statutory since they may be preformed within the human mind.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7, 9-12, 15, 17-20 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Quatse et al (US 2005/0010472).

As per claim 1, Quatse et al disclose a method for selecting an optimal set of events to be performed, where each event has a value and where the selection of any event reduces or leaves unchanged the value of unselected events (i.e., limited lists and tree structured lists of promotional offers to targeted customers, ¶ 0018), comprising: performing a first sort on all unselected events to form a pending event

list, so that the events are ordered sequentially by their values, with the highest-valued event being at the top of the pending event list (i.e., ordered list of offers which are ordered by score, ¶ 0018); selecting the highest-valued unselected event upon the occurrence of a predetermined trigger (i.e., only a limited number of offers having the highest estimated probability are allocated to distribution list, ¶ 0018); recomputing the values of each event after the selection of the highest-valued unselected event (i.e., targeting process uses statistical methods and rule based inferences to score each promotional offer, ¶ 0018); and moving the highest-valued unselected event, after performance of the recomputing step, to the top of the pending event list without performing a second sort of the entire pending event list (i.e., only a limited number of offers having the highest estimated probability are allocated to distribution list, ¶ 0018).

As per claim 2, Quatse et al disclose the selecting, recomputing, and moving steps are iteratively performed until the occurrence of a predetermined condition (i.e., only a limited number of offers having the highest estimated probability are allocated to distribution list complying with constraints including limits on the number of offers, ¶ 0018).

As per claim 3, Quatse et al disclose said predetermined condition comprises the selection of a predetermined number of events (i.e., constraints including limits on the number of offers, ¶ 0018).

As per claim 4, Quatse et al disclose each event has a cost associated with its selection, whereby said predetermined condition comprises the reaching of a

predetermined cost total for said selected events (i.e., only distribution of promotional offers likely to be effective, thus reducing the cost, ¶ 0014).

As per claim 7, Quatse et al disclose the value of each event comprises its each events expected gain (i.e., targeting process uses statistical methods and rule based inferences to score each promotional offer, ¶ 0018).

Claims 9-12 and 15 are rejected based upon the same rationale as the rejections of claims 1-4 and 7, respectively, since they are the system claims corresponding to the method claims.

Claims 17-20 and 23 are rejected based upon the same rationale as the rejections of claims 1-4 and 7, respectively, since they are the computer program product claims corresponding to the method claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, 8, 13, 14, 16, 21, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quatse et al (US 2005/0010472).

As per claim 5, Quatse et al does not explicitly disclose said moving step comprises the performance of a truncated bubble sort on the events based on their recomputed values. However, Quatse et al disclose segmenting (i.e., sorting) based

upon well known clustering algorithms (§ 0048). Moreover, truncated bubble sorts are old and well known, and it would have been obvious to one of ordinary skill in the art to include performance of a truncated bubble sort in the system of Quatse et al, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 6, Quatse et al does not explicitly disclose said moving step comprises the performance of a binary chop sorting process on the events based on their recomputed values. However, Quatse et al disclose segmenting (i.e., sorting) based upon well known clustering algorithms (§ 0048). Moreover, binary chop sorting is old and well known, and it would have been obvious to one of ordinary skill in the art to include performance of a binary chop sorting process in the system of Quatse et al, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 8, Quatse et al does not explicitly disclose said recomputing process comprises performing a saturation process on said unselected events. However, Quatse et al disclose segmenting based upon well known clustering algorithms (§ 0048). Moreover, performing a saturation process is old and well known, and it would have been obvious to one of ordinary skill in the art to include

performing a saturation process in the system of Quatse et al, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 13, 14 and 16 are rejected based upon the same rationale as the rejections of claims 5, 6 and 8, respectively, since they are the system claims corresponding to the method claims.

Claims 21, 22 and 24 are rejected based upon the same rationale as the rejections of claims 5, 6 and 8, respectively, since they are the computer program product claims corresponding to the method claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Martin (US 2007/0055570) discloses determining effectiveness of sales call efforts.

-Brierley et al (US 2002/0161779) disclose populating and analyzing a member consumer profile.

-Eder (US 2004/0193503) discloses improving financial performance of a sales process.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/
Primary Examiner, Art Unit 3623
June 21, 2008